



PATENT

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March 16, 2006

Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number: 09/405,731

Filing Date: 9/24/1999

Applicant(s): Thomas L. DiStefano, III

Entitled: MODERATING EXTERNAL ACCESS TO AN ELECTRONIC
DOCUMENT AUTHORIZING, DEVELOPMENT AND
DISTRIBUTION SYSTEM

Examiner: Clement B. Brown

Group Art Unit: 3628

Attorney Docket No.: 1115-5U

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request that a Panel Review of the rejections in the Office Action dated November 17, 2005, be performed in the above identified application.

REMARKS

**CLAIMS 1-20 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON
LUDWIG ET AL., U.S. PATENT NO. 6,816,904 (HEREINAFTER LUDWIG)**

Although the Examiner dedicated five whole pages to discussing the present rejection in the Office Action dated November 17, 2005, the Examiner could have simply written:

Claims 1-20 are rejected based upon the Abstract, column 21, lines 4-30 and columns 7-12 (lines 1-65 of each column) of Ludwig.

Nothing more need be written since the Examiner's entire statement of rejection consisted of reproducing entire paragraphs of the claims and asserting that each of these limitations are disclosed by "column 21 lines 4-30 and column 7-12 lines 1-65." The only variations to that quote was a result of typographical errors, and in one instance (i.e., claim 1), the Examiner also referred to the Abstract of Ludwig.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

Ludwig being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).³

The manner in which the Examiner conveyed the statement of the rejection has not "designated as nearly as practicable" the particular parts in Ludwig being relied upon by the Examiner in the rejection. It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Ludwig being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing a long passage, an entire paragraph, or several columns within a reference to disclose a single (or even multiple) claimed element does not designate "as nearly as practicable," the particular features being relied upon by the Examiner in the rejection.

By failing to identify the elements of the claims; construe a meaning for these elements; and identify where these elements are disclosed by the applied reference, the Examiner has forced Applicant to engage in mind reading to determine how the Examiner is interpreting the elements of the claims and what features the Examiner believes identically discloses the claimed

³ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

invention. Essentially, the Examiner is placing the burden on Applicant to prove that Ludwig does not disclose the claimed elements based upon Applicant's interpretation of the claims and Applicant's comparison of the claims with the applied prior art. This shifting of the Examiner's burden to the Applicant to establish patentability, however, is premature since the Examiner has still not discharged the initial burden of providing a prima facie case of anticipation.

In the unpublished opinion of Ex parte Pryor⁴, the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to supply sufficient information to establish a prima facie case of anticipation. Specifically, the Board wrote:

At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements between the instant claims and the applied reference, fails to clearly make out a prima facie case of anticipation. (emphasis in original)

Notwithstanding the gross failure by the Examiner to set forth a proper prima facie case of anticipation, Applicant notes that independent claims 1 and 11 each introduce the concept of a third party registering as a registered user. However, not only are the passages cited by the Examiner completely silent with regard to this limitation, a textual search of Ludwig using the terms "register," "registration," and "registering" yields no matches. Although column 21, lines 4-30 describes "a successful login," this does not identically disclose the claimed third party registering as a registered user. Moreover, it is not readily apparent that Ludwig teaches that a third party is first permitted restricted access to selected functions of an electronic authoring, development and distribution system and that all these access restrictions are eliminated upon the third party registering as a registered user, as recited in claims 1 and 11.

⁴ Appeal No. 1997-2981.

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Other examples include claims 3-4 and 13-14 reciting "credit card information," which does not appear to be disclosed by Ludwig. Claims 6 and 16 recite registering a unique URL on behalf of the registered user, which does not appear to be disclosed by Ludwig. Claims 7 and 17 recite submitting a URL to a plurality of search engines yet the concept of search engines appear to be absent from Ludwig. The concept of compensation recited in claims 8 and 18 also appear to be absent from Ludwig. For sake of brevity, Applicant notes that the preceding is a shortened list of all the limitations that do not appear to be identically disclosed by Ludwig.

Therefore, for all the reasons stated above, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of anticipation within the meaning of 35 U.S.C. § 102 in rejecting claims 1-20 based upon Ludwig.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: March 16, 2006

Respectfully submitted,



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